

Attorney Docket No. 101948002US

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated April 7, 2004, are respectfully requested.

The attorneys for the applicant wish to thank the Examiner for the thorough Office Action, including the specific citations to portions of the applied references and the elements of the claims to which those portions relate.

I. Disclosed Embodiments of the Invention

Embodiments of the invention are directed to a system that receives telephone calls or other continuous information streams, where these streams include spoken address information. The spoken address information can include various electronic addresses embedded therein, such as telephone numbers, email addresses, Uniform Resource Identifiers (URI), and so forth. Thus, as opposed to existing "voice dial" systems, whereby a user of a mobile phone may enter a special mode and audibly voice commands including phone numbers, embodiments of the invention monitor an ongoing voice stream (live or recorded) as a background process to identify electronic addresses. Once activated, the process monitors the incoming voice streams to identify electronic addresses and extract or convert these addresses into a format so that they may be used automatically. For example, in one embodiment the voice recognition system scans or evaluates a voicemail message and identifies portions of the message possibly containing address information. Application at [0045]. The identified address information may then be extracted and formatted, e.g., converted from speech to text or otherwise converted into an alphanumeric string, and made available to a user of a portable communication device, who may then provide user input (e.g., to press the " * " button) to quickly connect to some external device associated with that electronic address.

Under another embodiment of the invention, the system employs pattern recognition and parses through a live or recorded audio stream for select spoken phrases, such as "my number is," "call me at," "leave me a message at," "my email address is," as well as other voice patterns described in the application, such as at [0052]. Thus, this embodiment of the invention may improve the background scanning of voice streams to identify spoken phrases indicating existence of a spoken electronic address.

II. The Applied Art

US Patent No. 5,652,789 to Miner et al. ("*Miner et al.*") is directed to a network based knowledge assistant that recognizes speech and performs functions within the familiar office model. The system of *Miner et al.* employs a traditional voice interface like a "voice dial" system, whereby users can dial phone numbers and perform other actions using the voice interface. For example, users can create new contacts by copying them from an electronic phone book. A subscriber must add a voice identification to a phone book entry that is to be added to a contact list so that the new contact may be identified via the voice interface. See e.g., column 39, lines 43-47. A contact can also be created when receiving a message (where a "contact" is analogous to an entry in an address book file, while a "message" is commonly a voice mail message). Column 39, lines 48-54; column 5, lines 58-62, and column 6, lines 10-12. In particular, a subscriber can say "yes" in response to the assistant asking if the subscriber wishes to transfer the contact out of the message and into the subscriber's contact list. As a result, the user again must add a voice identification. Id.

Importantly, whenever a caller calls into the system of *Miner et al.*, the system enters a call handling mode or otherwise employs call handling functions using an "electronic assistant." See, e.g., column 32, lines 1-. The system attempts to recognize a database entry for the caller when the caller utters his or her name in response to a system inquiry. Column 7, lines 18-28. If the system cannot

recognize the caller, for example, if there is no database entry, then the system actively solicits the caller to use DTMF push button entry to provide the caller's area code and phone number. Column 7, lines 29-36. If the system can still not identify the caller, then the caller is labeled as unknown. Column 7, lines 50-54. Thus, under the system of *Miner et al.*, the caller's spoken name and phone number are already stored in the database, or the caller speaks his/her name and provides a phone number via DTMF input. With an unknown caller, the system apparently appends the DTMF input as the enclosed contact. See, e.g. column 33, lines 29-37.

US Patent Application No. 2004/006,2365 to Agraharam et al. ("*Agraharam et al.*") discloses a voice messaging system for converting oral messages into text. *Agraharam et al.* allows a calling party to send an electronic mail message by first soliciting the caller to provide information in order to compose and transmit the email message. Paragraph [0013]. After soliciting the caller to provide an email address, the email address may be obtained by either having the calling party speak the email address, enter the email address using the telephone's keypad, or speaking the recipient's name and looking up the recipient's email address in a database. Paragraphs [0014] and [0015]. In either case, *Agraharam et al.* specifically requires the system to actively solicit the user for either spoken or keypad input. Thus, as with *Miner, et al.*, the system of *Agraharam et al.* employs a special, active mode for processing a spoken message that engages a caller via a voice interface or audible menu of choices.

II. Rejections under 35 U.S.C. § 102

Distinctions between claim 1 and *Miner et al.* will first be discussed, followed by distinctions between *Miner et al.* and the remaining independent claims.¹

¹ Silence regarding a position taken, or argument made, by the Examiner does not indicate any acquiescence to that position or argument. Furthermore, arguments made with respect to a particular claim or claims apply only to that claim or claims, and not to other claims, unless specifically noted herein.

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The applicant respectfully submits that the applied references, not only *Miner et al.* but those applied in the previous Office Action, fail to disclose a background process for monitoring an ongoing audible transmission to identify voiced address information. These applied references need only recognized discrete spoken segments, and differentiate between such segments under a special, active mode. As noted above, the applied references effectively require specific prompting (a special mode) for actively soliciting address or other information from a caller, rather than passively obtaining such information during an ongoing voice stream. The applicant respectfully submits that the applied references, including *Miner et al.*, fail to disclose automatically recognizing or identifying, and then extracting, telephone numbers from continuous voice streams.

Claim 1 as previously pending recited, among other limitations, a method for automatically recognizing or identifying electronic addresses from a received "telephone call." This is in contrast to discrete spoken phrases (e.g., names) commands or digits/characters received under a special mode. A telephone call represents a continuous stream of audible information that may include within it voiced address information; *Miner et al.* specifically solicits a user under a "call handling function" for single discrete user input (such as the caller's name), or DTMF input, as noted above. (*Miner et al.* also invokes an "active gadget" to play prompts, record incoming signals, perform DTMF recognition, and so forth. See e.g., column 32, lines 26-45. An electronic assistant under *Miner et al.* also handles the incoming call. Column 33, lines 5-.) For at least these reasons, the applicant believes claim 1 is patentable over *Miner et al.*

However, claim 1 has been amended to clarify the inherent language of previously pending claim 1. In other words, claim 1 has been amended to recite, among other limitations, that the method includes automatically identifying electronic addresses wherein when the identifying is performed without first actively querying or soliciting a caller for the electronic address. As noted above, *Miner et al.* provides

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numerous active inquiries to a caller, such as asking the caller to state his or her name, and if a recognition fails, to input a telephone number via DTMF, and so forth. Thus, the system of *Miner et al.* operates under a special mode, namely an active caller inquiry and database lookup mode. The method of claim 1 further clarifies that the identifying is performed without need for querying a database for the electronic address that previously exists within the database. For at least this additional reason, claim 1 is patentable over *Miner et al.*

As is known, to anticipate a claim under 35 U.S.C. § 102, the reference must teach every element of the claim.² *Miner et al.* fails to disclose every limitation recited in claim 1. Thus, for at least the above reasons, the applicant respectfully submits that claim 1 is patentable over *Miner et al.*

The remaining independent claims are allowable for similar reasons. Claims 13 and 21 recite a system that includes, *inter alia*, limitations substantially similar to those noted above. Claim 16 recites that received verbal data is "substantially continuous," in that the recited portable telephone system identifies spoken address information among the substantially continuous verbal data. Further, claim 16 recites that the identifying is performed without need for querying a database for the electronic address, or querying the database for an identity of the caller. Overall, independent claims 1, 13, 16, and 21 are allowable over *Miner et al.*

² MPEP section 2131, p. 70 (Feb. 2003, Rev. 1). See also, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990) (to establish a *prima facie* case of anticipation, the Examiner must identify where "each and every facet of the claimed invention is disclosed in the applied reference."); *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995) (anticipation requires that each claim element must be identical to a corresponding element in the applied reference); *Atlas Powder Co. v. E.I. duPont De Nemours*, 750 F.2d 1569, 1574 (1984) (the failure to mention "a claimed element (in) a prior art reference is enough to negate anticipation by that reference").

II. Rejections under 35 U.S.C. § 103

The Applied References Even if Combined, Fail to Disclose or Suggest the Claimed Invention.

As noted above, *Miner et al.* discloses a method whereby a system, in a special mode or via an electronic assistant, actively solicits callers for discrete spoken data. *Miner et al.* fails to disclose email address handling, such as in a voicemail message. *Agraharam et al.* discloses email handling for voicemail to email. As explained below, *Miner et al.* and *Agraharam et al.* would not be combined. However, even if they were combined, neither *Miner et al.* nor *Agraharam et al.* extract electronic address information in a continuous voice stream under a live telephone call. Moreover, both *Miner et al.* and *Agraharam et al.* require a special mode to process spoken addresses. Claim 12 recites, among other limitations, automatically recognizing and extracting electronic addresses from received voice streams, using automatic voice recognition during normal reception of the voice stream and not under a special mode. The voice streams are continuous, as opposed to discrete, streams of voice information provided under either live telephone calls or recorded voice messages. These features are not disclosed in either *Miner et al.* or *Agraharam et al.*

Claim 19 recites similar limitations and notes that the recognition and connection system performs background or passive voice recognition analysis on continuous streams of live calls and recorded information. Claim 22 recites, among other limitations, means for identifying voiced address information by parsing through a voicemail message without previously querying a caller to input the electronic address. Thus, for similar and additional reasons, claims 19 and 22 are patentable over *Miner et al.* and *Agraharam et al.*

The Applied References (1) Lack a Specific Suggestion to Combine Them As Argued in the Office Action, (2) Fail to Identify Advantages for Combining the References, and (3) Teach Away from Combining the References

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Independent claims 12, 19 and 22 are allowable not only because they recite limitations not found in the references (even if combined), but for at least the following additional reasons. For example, there is no motivation to combine the various references as suggested in the Office Action. According to the Manual of Patent Examining Procedure ("MPEP") and controlling case law, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, but instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, the Federal Circuit recently rejected an argument by the PTO's Board of Patent Appeals and Interferences that the ability to combine the teachings of two prior art references to produce beneficial results was sufficient motivation to combine them, and thus overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two references.³ The MPEP provides similar instructions.⁴

Conversely, and in a manner similar to that rejected by the Federal Circuit, the applicant respectfully submits that the present Office Action lacks a sufficient description of a motivation to combine the references. Thus, if the current rejection is maintained, the applicant's representative requests that the Examiner explain with the required specificity where a suggestion or motivation in the references for so combining the references may be found.⁵

As is known, one may not use the application as a blueprint to pick and choose teachings from various prior art references to construct the claimed invention

³ In re Sang-Su Lee, 277 F.3d 1338, 1341-1343 (Fed. Cir. 2002).

⁴ Manual of Patent Examining Procedure, Section 2143 (noting that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure," citing in re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

⁵ See, MPEP Section 2144.03.

("impermissible hindsight reconstruction").⁶ Assuming, for argument's sake, that it would be obvious to combine the teachings of *Miner et al.* and *Agraharam et al.*, then *Miner et al.* would have done so because it would have provided at least some of the advantages of the presently claimed invention. *Miner et al.*'s failure to employ the teachings cited in *Agraharam et al.* is persuasive proof that the combination recited to reject claim 12 is unobvious. Similar arguments apply to claims 19 and 22.

Moreover, an invention may be unobvious, even where all the elements are found in the prior art references, provided the references do not suggest the *advantage* to be gained by combining the references. *In re Semaker*, the Federal Circuit stated that

[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.⁷

None of the applied references appear to address the problem of, for example, receiving a continuous stream of voice data (either live or recorded) and automatically extracting electronic address data (phone numbers, email, URI), without the user responding to active queries or requiring a special mode.

Possibly more importantly, *Miner et al.* teaches away from embodiments of the present invention. A key feature of *Miner* is to encourage active interaction with the voice interface in the system of *Miner et al.* In contrast, the system of claim 12 (and other claims) automatically parses through streams of live or recorded audio to passively identify spoken electronic address information. This is in direct opposition to the motivation for the system of *Miner et al.* Thus, one skilled in the art would not be motivated to combine *Miner et al.* with *Agraharam et al.*

⁶ See, e.g., *In re Gorman*, 933 F.2d 982,987 (Fed. Cir. 1991), ("One cannot use hindsight construction to pick and choose between isolated disclosures in the prior art to deprecate the claimed invention.").

⁷ 217 U.S.P.Q. 1, 6-7 (Fed. Cir., 1983).

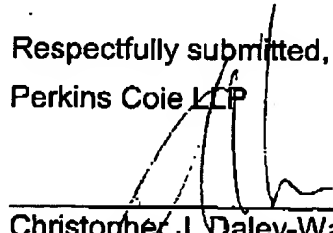
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III. Conclusion

Overall, the applicant respectfully submits that independent claims 1, 12, 13, 16, 19 and 21-22 are patentable over the applied references. Since these independent claims are allowable, based on at least the above reasons, the claims that depend from them are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, Examiner Gauthier is requested to point out specifically where such teaching may be found.

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If Examiner Gauthier has any questions or believes a telephone conference would expedite prosecution of this application, he is encouraged to call the undersigned at (206) 359-3599.

Respectfully submitted,
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